



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/811,258

03/26/2004

Michael R. Hynes

L-F / 227

1651

26875 7590 05/12/2009

WOOD, HERRON & EVANS, LLP

2700 CAREW TOWER

441 VINE STREET

CINCINNATI, OH 45202

EXAMINER

MOULTON, ELIZABETH ROSE

ART UNIT

PAPER NUMBER

3767

MAIL DATE

DELIVERY MODE

05/12/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/811,258  
Filing Date: March 26, 2004  
Appellant(s): HYNES, MICHAEL R.

\_\_\_\_\_  
Thomas W. Humphrey  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 30 January 2008 appealing from the Office action mailed 30 July 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

4,466,426	Blackman	8-1984
4,246,898	Travalent	1-1981

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Trivalent et al (US 4,246,898).

Trivalent teaches a syringe (10) with pushrod (22), a scale (60), threads (see claim 3, and 54, Fig 1), a stop (56) moveable relative to the scale along the shaft of the pushrod, the shaft including a thumb rest (32) and the syringe barrel having a flange (24) which abuts the stop (Fig 1). The shaft is made of plastic, which is generally molded. Also, molded is a product-by-process limitation and is given little patentable weight.

2. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Blackman (US 4,466,426).

Blackburn teaches a syringe (10) with known volume (scale 38 and 40) with pushrod (20), a scale (lines at 32a and 32b), threads (see 32a, 32b, and 36e), a stop (36) moveable relative to the scale along the shaft of the pushrod, the shaft including a thumb rest (24) and the syringe barrel having a flange (28) which abuts the stop (Fig 1). The shaft is made of metal, which may be molded. Also, molded is a product-by-process limitation and is given little patentable weight.

### **(10) Response to Argument**

#### **Trivalent:**

Appellant argues that Trivalent shows a syringe filled to a "particular filled volume." This appears to meet the limitation of a "known" volume. Appellant then notes that the syringe must be filled to align the plunger at the "0" position to accurately

dispense medication. Appellant seems to confuse the limitation of a "prefilled syringe." There is no special definition of a prefilled syringe in the specification or in the art. The examiner finds that any syringe which contains medication for expulsion is prefilled. A syringe which is empty, connected to a bulk medication bottle, and filled is then considered "prefilled" whether the filling takes place during manufacture or immediately prior to injection. An example of a syringe which is not prefilled would be a syringe which is fully empty connected to a patient for blood withdrawal. The syringe of Travalent could be over filled and then reset so that the plunger rests at "0" and still be prefilled. Travalent expressly discloses that the plunger is calibrated to the volume of the syringe: see Col 3 line 57- Col 4 line 14. Appellant's arguments as to "properly filling" the syringe are not related to limitations or steps found in the claims.

**Blackman:**

Appellant argues that the measuring grooves 32a/b do not indicate a specific volume. This is not true, and not in the claims. The measuring grooves "correspond to a predetermined volume" (Col 4 line 64). Appellant next argues that the measuring grooves are not a scale. The definition of scale is "an instrument or apparatus with graduated markings for measuring something" (Encarta). The measuring grooves are evenly spaced and intended for determining the amount of medication injected. There is nothing requiring printed numbers on the scale in the claim. Next appellant asserts the Blackman's clip 36 is not a "stop." A stop as claimed must be "moveable relative to the scale" and "configured for location along the shaft." Clearly the clip 36 meets these limitations, see Fig 2 and Fig 3.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/ELIZABETH R MOULTON/

Examiner, Art Unit 3767

Conferees:

/Kevin C. Simmons/

Supervisory Patent Examiner, Art Unit 3767

/Janet C. Baxter/  
TC 3700 TQAS